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SCULLY, SCOTT, MURPHY & PRESSER, P.C.			RAO, SHRINIVAS H	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY C. KRYWANCZYK, DONALD W.
BROUILLETTE, STEVEN A. MARTEL and
MATTHEW R. WHALEN

Appeal 2009-012798
Application 10/715,689
Technology Center 2800

Decided: June 15, 2010

Before EDWARD C. KIMLIN, TERRY J. OWENS, and
PETER F. KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-9, 11, 12, 14, 16-19 and 30-35, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim an ultraviolet (UV) light curable tape. Claim 1 is illustrative:

1. A UV energy curable tape comprising:
a support layer;
an adhesive material positioned on said support layer, and
including a UV energy curable oligomer, a UV energy initiator, and a
material which starts to emit optical light of a first type when said tape
becomes substantially fully cured.

The Reference

Moon WO 92/15651 Sep. 17, 1992

The Rejection

Claims 1-9, 11, 12, 14, 16-19 and 30-35 stand rejected under 35 U.S.C. § 102(b) over Moon.

OPINION

We reverse the rejection.

Issue

Have the Appellants indicated reversible error in the Examiner's determination that Moon discloses a tape comprising a material which starts to emit optical light when the tape becomes substantially fully cured?

Findings of Fact

Moon makes acrylic-based adhesives, especially pressure-sensitive adhesive tapes, by forming a monomeric mixture or partially prepolymerized syrup comprising at least one acrylic acid ester of an alkyl alcohol containing 1-14 carbon atoms, an optional copolymerizable monomer and a photoinitiator, irradiating the monomeric mixture or syrup with light to form an acrylic copolymer, and thereafter irradiating the acrylic copolymer with light to substantially complete the photopolymerization of the acrylic

copolymer (p. 3, l. 18 – p. 4, l. 16). “Other materials which can be blended with the polymerizable monomer mixture include fillers, tackifiers, foaming agents, antioxidants, plasticizers, reinforcing agents, dyes, pigments, fibers, fire retardants, and viscosity adjusting agents” (p. 7, ll. 18-21).

Analysis

The Examiner has the initial burden of establishing a *prima facie* case of anticipation by pointing out where all of the claim limitations appear in a single reference. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986).

The Examiner argues that “becomes substantially fully cured” is a hybrid product by process and particular use/functional recitation limitation for which no patentable weight can be given unless it is in means plus function format (Ans. 10).

When claims are interpreted, all limitations must be given effect. *See In re Angstadt*, 537 F.2d 498, 501 (CCPA 1976) (“we *must* give effect to *all* claim limitations”). Thus, the Examiner’s argument that the Appellants’ “becomes substantially fully cured” limitation cannot be given patentable weight because it is not in means plus function format is legally erroneous. The claim requirement that the material starts to emit optical light when the tape becomes substantially fully cured is a characteristic of that material and must be considered in determining patentability of the Appellants’ claims.

The Examiner argues that Moon discloses, at page 7, lines 18 to 21, UV dyes similar to the Appellants’ UV dyes (Spec. 9:17 – 10:5) (Ans. 10).

That portion of Moon merely discloses “dyes” (p. 7, l. 20), not UV dyes or any specific dye.

The Examiner argues that Moon's dyes inherently emit light when the tape is substantially fully cured because Moon is using the same material for the same purpose (Ans. 12).

Moon merely discloses "dyes" (p. 7, l. 20) and does not describe the dyes. The Examiner has not established that Moon's dyes are the same as the Appellants' UV dyes or that a dye's emitting light when a tape containing the dye becomes substantially fully cured is an inherent characteristic of dyes in general.¹ *See Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) ("Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981))). Nor has the Examiner established that Moon uses the dye for the same purpose as the Appellants, i.e., emitting light when the tape becomes substantially fully cured.

Conclusion of Law

The Appellants have indicated reversible error in the Examiner's determination that Moon discloses a tape comprising a material which starts to emit optical light when the tape becomes substantially fully cured.

DECISION/ORDER

The rejection of claims 1- 9, 11, 12, 14, 16-19 and 30-35 under 35 U.S.C. § 102(b) over Moon is reversed.

¹ The Appellants argue that Moon does not disclose that the dyes start to emit optical light when the tape becomes substantially cured (Br. 7; Reply Br. 5) and that such optical light emission is not inherent in dyes (Reply Br. 6).

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It is ordered that the Examiner's decision is reversed.

REVERSED

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